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MESSAGE: **FORMAL SUBMISSION OF:**
1) Transmittal (1 pg.); and
2) Reply Brief (13 pgs.).

Attorney Docket No.: **Google-41 (GP-099-00-US)**

Appl. No.: **10/750,451**

Applicants: **Ross KONINGSTEIN, et al.**

Filed: **December 31, 2003**

Title: **SUGGESTING AND/OR PROVIDING TARGETING CRITERIA FOR
ADVERTISEMENTS**

TC/A.U.: **3622**

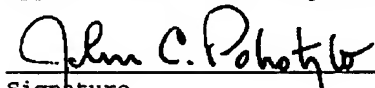
Examiner: **Michael Bekerman**

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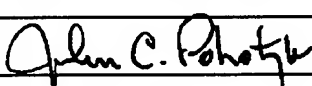
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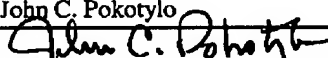
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Filing Date	December 31, 2003
First Named Inventor	Ross KONINGSTEIN
Group Art Unit	3622
Examiner Name	Michael Bekerman
Total Number of Pages in This Submission	Attorney Docket Number Google-41 (GP-099-00-US)

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S I R:

REPLY BRIEF

Further to the Examiner's Answer mailed on September 5, 2007 ("Examiner's Answer"), which, together with 37 C.F.R. § 41.41(a), defines a period for reply to expire on November 5, 2007, the Appellant requests that the Board consider this Reply Brief.

Argument

This Reply Brief incorporates by reference, the Appeal Brief filed on June 25, 2007 ("Appeal Brief"). Accordingly, the arguments presented in this Reply Brief are intended to *supplement, not replace*, arguments presented in the Appeal Brief. Further, since the arguments presented here are intended to supplement arguments in the Appeal Brief, the claims are to be grouped in accordance with the separate headings providing in the Appeal Brief and nothing in this Reply Brief shall constitute a waiver of any argument that the Board must consider the patentability of the separately grouped claims separately.

Reply to "Response to Argument" Section of the Examiner's Answer

In the "Response to Argument" section (pages 8-17) of the Examiner's Answer, the Examiner (1) ignores or misrepresents certain claim recitations, (2) introduces arguments without proper support (e.g., a hypothetical electronic thesaurus, an assertion that he is one of skill in the art), and (3) applies improper legal standards (e.g., "plausible interpretation" and "could be theorized"). Each of these issues is addressed below.

On pages 8 and 9 of the Examiner's Answer, the Examiner alleges that (1) the claimed "category" reads on a "word", (2) in the claim element "providing at least some of the keywords as one or more ad targeting

keywords," the phrase "as one or more ad targeting keywords" is merely an intended use since there are no positively claimed steps of serving advertisements using the search terms as serving constraints, and (3) a hypothetical electronic thesaurus (not of record and not established as prior art) teaches the invention of claim 1.

First, the Examiner alleges that the claimed category reads on a "word." In the Examiner's Answer, the Examiner uses the fact that "automobile" is used as an example of a search term in the Paine publication and a category in the present application in an attempt to prove that search terms and keywords are the same as categories. *However, the fact that a particular term might be used as a label representing a category does not mean that the same term, when used as a search term, represents a category.* Specifically, the Examiner's argument is apparently that since certain words might sometimes be a label representing a category, a word is inherently a category. This is clearly improper under the well-established case law which requires that an anticipatory inherent feature or result be consistent, necessary and inevitable, not merely possible or probable. (See, e.g., Transclean Corp. v. Bridgewood Services, Inc., 62 U.S.P.Q.2d 1865 (Fed. Cir. 2002); See also, Eli Lilly & Co. v. Barr Laboratories, Inc., 58 U.S.P.Q.2d 1865 (Fed. Cir. 2001), cert. denied, 122 S.Ct. 913 (2002).) That is, the Examiner's allegation that a particular word *might be* used as a label representing a category constitutes, at best, a possible result (not a consistent, necessary, or inevitable result) under the

applicable case law. A possible (or accidental) result does not constitute an anticipation.

The Examiner also argues that the Appellant's specification uses "category" and "keyword" interchangeably to perform the same functions, and as an example cites that keywords can be used to lookup categories and categories can be used to lookup keywords. (See Examiner's Answer, page 11.) The Appellant respectfully disagrees and refers the Board to pages 16-19 of the Appeal Brief. In addition, the facts that (1) keywords can be used to lookup categories, and (2) categories can be used to lookup keywords does not make them equivalent. For example, a keyword can "belong to" one more categories, and a category may "include" one or more keywords. These are clearly different relationships.

The Examiner also alleges that the Appellant never specifically defines category. (See Examiner's Answer, page 11.) However, a specific definition is not required. In any event, as discussed on pages 16-19 of the Appeal Brief, the term "category" has an established definition in the art of electronic advertising and electronic commerce, and examples, consistent with this well-established meaning, are provided in the specification. Thus, the Examiner's interpretation of "categories" is inconsistent with both (1) the interpretation that one of ordinary skill in the art would have used and (2) the specification, and is therefore improper. (See MPEP 2111.)

To summarize, the claimed "categories" cannot be properly characterized as "keywords".

Second, the Examiner alleges that in the claim element "providing at least some of the keywords as one or more ad targeting keywords," the phrase "as one or more ad targeting keywords" is merely an intended use since there are no positively claimed steps of serving advertisements using the search terms as serving constraints. (See Examiner's Answer, page 8.) The Appellant disagrees.

As best understood by considering its unparsed form, in the claim element "**providing** at least some of the keywords **as one or more ad targeting keywords**," (Emphasis added.), the phrase "as one or more ad targeting keywords" modifies the verb "providing" and is therefore not a mere intended use. Rather, the keyword(s) are provided (added to ad information) as a targeting keyword(s).

The fact that there is no positively claimed step of serving the advertisements using these search terms as serving constraints does not alter this fact. In addition to its potential use by entities such as Google that both (1) help advertisers develop targeted advertisements, and (2) serve such targeted advertisements, an invention consistent with claim 1 could be used by a vendor which helps advertisers develop a targeted advertisement, even if the vendor does not itself serve ads.

To summarize, the phrase "as one or more ad targeting keywords" modifies the verb "providing" and is therefore not a mere intended use.

Finally, the Examiner alleges that a hypothetical electronic thesaurus teaches the invention of claim 1.

Since the Examiner has not demonstrated that the hypothetical electronic thesaurus is prior art under 35 U.S.C. § 102, neither the Board, nor the Appellant, can properly assess, and/or respond to the Examiner's argument. The Examiner does not allege that the Paine publication teaches an electronic thesaurus. (It does not.) Accordingly, the Appellant submits that the Board should give this argument the weight that it deserves -- none.

To reiterate, the foregoing is intended to supplement, not replace the arguments provided in the Appeal Brief.

With regard to the rejection of claims 2, 15, 28-30, 43, 66, and 69 under 35 U.S.C. § 112, ¶ 2 as being incomplete for omitting essential elements, despite the Appellant's detailed discussion on pages 9-12 of the Appeal Brief, the Examiner questions, "how a negative keyword may make an advertisement ineligible to be served when no advertisements are ever served by anyone in the first place." (Examiner's Answer, page 9) As an analogy, a person not having U.S. citizenship is ineligible to become the President of the United States under the U.S. Constitution. The fact that such a person is *ineligible* to become the President *applies to (is a characteristic of) the person regardless of whether or not* the person is running for President and *regardless of whether or not* there is (or ever was) a Presidential election. In the same way, a negative keyword may be "used to make the ad ineligible to be served for requests

including the negative keyword," regardless of whether or not the advertisement is ever served.

To reiterate, the foregoing is intended to supplement, not replace the arguments provided in the Appeal Brief.

With regard to the rejection of claims 12, 13, 25, 26, 38, 39, 53, 54, 66, 67, 79 and 80 for omitting essential steps, in response to the Appellant's statement that unused ad spots or unused inventory might be available and simply accepted, the Examiner argues that "there is never an active step in the claims of 'accepting unused ad spot or unused inventory information' (which would be a step of determining the unused ad spots)." (Examiner's Answer, page 10) The Appellant respectfully notes that the fact that such information is used by the act of providing at least some of the keywords as one or more ad targeting keywords infers that such information was determined or accepted.

To reiterate, the foregoing is intended to supplement, not replace the arguments provided in the Appeal Brief.

Regarding the rejection of claims 1, 14, 42 and 55 as being anticipated by the Paine publication, the Examiner argues that "looking up" is a broad term (See Examiner's Answer, page 12.) and that the Paine publication uses a word to look up other words. The Appellant respectfully disagrees.

First, "looking up" has a well-established meaning the art (a function in which a previously constructed

index or table of values is searched for a desired item or items of information), and the use of the term in the specification is consistent with this meaning in the art. Note also that dependent claims 5, 18, 31, 46, 59 and 72 recite that the lookup uses an index. Using an index is also consistent with this well-established meaning of looking up in the art. Thus, the Examiner's interpretation of "lookup" or "looking up" is inconsistent with both (1) the interpretation that one of ordinary skill in the art would have used and (2) the specification, and is therefore improper. (See MPEP 2111.)

To reiterate, the foregoing is intended to supplement, not replace the arguments provided in the Appeal Brief.

In rejecting claims 86 and 87 as being anticipated by the Paine publication, the Examiner argues that in the Paine publication, "if a program is able to get one set of terms from another set of terms, those two sets of terms have to be inherently 'associated'." (Examiner's Answer, page 12) This argument ignores the fact that these claims further recite that **the association is used to lookup keywords**. That is, in claims 86 and 87, the association exists before the keyword(s) are looked up and provided (and **must exist before** since the association is used by the lookup). By contrast, in the Examiner's application of the Paine publication, the association **exists only after** the other set of terms is generated by the program.

To reiterate, the foregoing is intended to supplement, not replace the arguments provided in the Appeal Brief.

In rejecting claims **29, 30, 70 and 71** as being anticipated by the Paine publication, the Examiner states:

Appellant argues "although an advertiser website might be linked to an ad, these claims recite that the ad includes ad creative information for rendering the ad and an address of a landing webpage linked from the ad". The Examiner would like to point out that the Appellant is limiting an advertisement that has not been claimed.

(Examiner's Answer, pages 12 and 13) These claims further require that the ad landing page or ad creative **is used to determine the category** (which is used to lookup the keyword(s), at least some of which are provided as one or more ad targeting keywords). These further features are ignored.

To reiterate, the foregoing is intended to supplement, not replace the arguments provided in the Appeal Brief.

In rejecting claims 6, 19, 32, 47, 60 and 73 as being anticipated by the Paine publication, the Examiner argues that the Appellant does not specifically define the term "qualification testing," dubs himself as "one skilled in the art," and concludes, without substantiation, that his own broad definition of

"qualification testing" is appropriate. (See Examiner's Answer, pages 13 and 14.)

The Appellant has noted that the specification contains an example of qualification testing. This example is consistent with the meaning that one of ordinary skill in the art at the time of the invention would have used. (See the Appeal Brief, pages 23-26). The Examiner's unsubstantiated assertion that he is skilled in the art frankly does not properly establish the level of ordinary skill in the art at the time of the invention. (Is the Examiner of ordinary or extraordinary skill? When did the Examiner acquire this skill? Was it at the time of the invention?) The Appellant has provided evidence of how one of ordinary skill in the art at the time of the invention would interpret "qualification testing." In contrast, the Examiner has made a bald assertion of his opinion. The Appellant submits that the Board should give the Examiner's and Appellant's respectively arguments the weight that they deserve.

To reiterate, the foregoing is intended to supplement, not replace the arguments provided in the Appeal Brief.

In rejecting claims 11, 24, 37, 52, 65 and 78 as being unpatentable over the Paine publication, the Examiner applies a "**plausible interpretation**" standard to interpret the claim language, manufactures such a plausible interpretation, and concludes, again without substantiation, that the Examiner's made up "plausible interpretation" is an interpretation that would be used by one skilled in the art. (See Examiner's Answer, pages

14 and 15.) This is in contrast to the evidence provided by the Appellant on pages 28-31 of the Appeal Brief. The Appellant submits that the Board should give the Examiner's and Appellant's respectively arguments the weight that they deserve.

To reiterate, the foregoing is intended to supplement, not replace the arguments provided in the Appeal Brief.

In rejecting claims 12, 13, 25, 26, 38, 39, 53, 54, 66, 67, 79 and 80, the Examiner argues, "KSR [KSR International Co. v. Teleflex Inc., 82 U.S.P.Q.2d 1385 (2007)] forecloses the argument that a specific teaching is required for a finding of obviousness." (See Examiner's Answer, page 15.) However, in KSR, the Supreme Court did note that although not strictly required, the teaching-suggestion-motivation ("TSM") rationale is still informative and still may be used. In any event, the Examiner did not even:

- (A) combine prior art elements according to known methods to yield predictable results;
- (B) show a simple substitution of one known element for another to obtain predictable results;
- (C) use a known technique to improve similar devices (methods, or products) in the same way;
- (D) apply a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) choose from a finite number of identified, predictable solutions, with a reasonable expectation of success (''Obvious to try'');

(F) provide a variation of known work in one field of endeavor for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; or
(G) show TSM to arrive at the claimed invention.

Instead, the Examiner provided a "**could be theorized**" standard to address a problem not even contemplated by the Paine publication.

Although the Examiner alleges that the proposed modification is "common sense" (See Examiner's Answer, page 16.), such common sense can only be applied once the nature of the problem addressed by the claimed invention is appreciated. The Paine publication does not appreciate the nature of the problem addressed by these claims. Thus, the Paine publication does not render these claims unpatentable since it does not even contemplate the nature of the problem to be solved. (See, e.g., Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U.S. 45 (1923).)

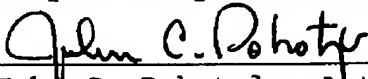
To reiterate, the foregoing is intended to supplement, not replace the arguments provided in the Appeal Brief.

Conclusion

In view of the foregoing, *as well as the arguments presented in the earlier filed Appeal Brief (incorporated herein by reference)* the Appellant respectfully submits that the pending claims are in condition for allowance. Accordingly, the Appellant requests that the Board reverse each of the outstanding grounds of rejection.

November 5, 2007

Respectfully submitted,



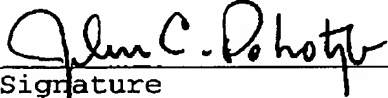
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